



402-038-19

IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: David G. McCarthy : Examiner: B. Hammond
Title: Retractable Receptacle : Group Art Unit: 2833
For Furniture :
Serial No. 08/951,276 :
Filed: October 16, 1997 :

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Mail Stop Appeal Brief - Patents


APPEAL BRIEF

I. INTRODUCTION -

This is an appeal from the final rejection of Claims 6, 19, and 20 made by the Primary Examiner in the Official Action dated August 8, 2007.

A Notice of Appeal was timely filed in the Patent & Trademark Office.

**I hereby certify that this correspondence is
being deposited with the United States Postal Service
as first class mail in an envelope addressed to
Commissioner for Patents, P.O. Box 1450, Alexandria,
VA 22313-1450, on the date indicated below.**


MARK P. STONE
Reg. No. 27,954

1/7/08
(Date of Deposit)

Appealed Claims 6, 19, and 20 are reproduced in the Appendix of Appealed Claims, attached hereto.

Applicant notes that a typographical error in Claim 19 as presented in the Amendment filed on October 26, 2006, has been corrected in Claim 19, as presented in the enclosed Appendix of Appealed Claims. More specifically, Claim 19 as presented in the October 26, 2006 Amendment, prior to the revisions made to the claim in that Amendment, was identical to Claim 19 presented for review in the prior Appeal which was decided by the Board on April 19, 2006. However, Claim 19 reproduced in the Amendment filed on October 26, 2006 omitted the phrase "and a housing mounted to an underside of said top surface of said article of furniture", at line 12 of the claim, as a result of a typographical error. This error has been corrected in Claim 19, as reproduced in the enclosed Appendix of Appealed Claims.

II. REAL PARTY IN INTEREST -

Electri-Cable Assembles, Inc. and Premier Manufacturing Group, Inc., both Connecticut corporations currently maintaining their principal place of business at 10 Mountain View Drive, Shelton, Connecticut 06484, are the real parties in interest.

III. RELATED APPEALS AND INTERFERENCES -

A prior Appeal by Applicant to the Board was made from a final rejection by the Primary Examiner dated August 31, 1999 for the present patent application. The August 31, 1999 final

rejection rejected Claims 1 - 20 (in a form identical to the form of Claims 1 - 20 presented for review in the present Appeal) both on formal grounds and on prior art grounds. Applicant's Appeal Brief, arguing both the formal and prior art grounds of rejection, was filed on January 9, 2000. In an Examiner's Answer filed on April 11, 2000, the Primary Examiner withdrew all grounds of prior art rejection raised in the Final Action dated August 31, 1999, but maintained the formal grounds of rejection raised in the Final Action dated August 31, 1999.

By Decision dated October 31, 2002, the Board reversed the formal grounds of rejection made in the Final Action dated August 31, 1999. A copy of the Board's prior decision is enclosed herewith in the "Related Proceedings Appendix".

Subsequent to the Board's Decision dated October 31, 2002, the application was remanded to the Primary Examiner. However, instead of issuing a Notice of Allowance since no outstanding grounds of rejection remained, the Examiner, in an Official Action dated March 7, 2003, without explanation, re-opened prosecution of the application on the merits, asserting prior art rejections against the claims based upon the same prior art references previously applied by the Examiner in the Final Action dated August 31, 1999 and expressly withdrawn by the Examiner in the Examiner's Answer dated April 11, 2000.

On April 15, 2003, subsequent to the receipt of the Official Action dated March 7, 2003 in which the Examiner re-opened prosecution of the application on the merits, Applicant filed a Petition To Commissioner Under 37 CFR. 1.181. The Petition argued that re-opening of prosecution on the merits after Decision On Appeal for the purpose of rejecting claims based upon the same prior art references applied by the Examiner prior to the Appeal and expressly withdrawn by the Examiner in the Examiner's Answer, violated the provisions of 37 CFR 1.198. By Decision On Petition dated November 19, 2003, the Director of Technology Center 2800 denied Applicant's Petition. On December 11, 2003, Applicant filed a Request For Reconsideration of the denial of the Petition. By Decision On Petition dated October 5, 2004, the Deputy Commissioner For Patent Examination Policy maintained the earlier Decision of the Director of Technology Center 2800. Copies of the original Petition to Commissioner, the Request For Reconsideration filed by Applicant, and the two (2) Decisions On Petition by the Patent & Trademark Office, are enclosed.

The Primary Examiner, in the Official Action dated November 18, 2004, placed all claims under Final Rejection based upon the same prior art applied in the earlier Official Action dated March 7, 2003 which re-opened prosecution of this application on the merits. The rejection of the claims was appealed to the Board. In a decision dated April 19, 2006, the Board affirmed the rejection of Claims 1 - 5 and 7 - 18 as being unpatentable over

Byrne and Mitchell, but reversed the rejection of Claims 1, 2, 4 - 7, 10, 12 - 15, 19 and 20 as being unpatentable over Mitchell alone. The decision also cited additional prior art which the Board considered to be relevant to the claimed subject matter. A copy of the Board's decision dated April 19, 2006 is enclosed in the "Related Proceedings Appendix".

Subsequent to the April 19, 2006 Board decision, the Primary Examiner issued an Official Action dated August 7, 2006 rejecting Claims 1, 6, 19 and 20. (Claims 1 - 5 and 7 - 18 were withdrawn in view of the Board decision dated April 19, 2006). An Amendment filed on October 23, 2006 rewrote dependent Claim 6 in independent form, and cancelled Claim 1 in view of the Board decision dated April 19, 2006. An Official Action dated February 6, 2007 rejected Claims 6, 19 and 20, and a response was filed on May 7, 2007. Claims 6, 19 and 20 were placed under final rejection in the Official Action dated August 8, 2007. A Request For Reconsideration After Final Rejection was filed on August 14, 2007, and an Advisory Action dated September 18, 2007 maintained the rejection of Claims 6, 19 and 20. A Notice of Appeal presenting the rejection of Claims 6, 19 and 20 for review in the instant Appeal was filed on November 5, 2007.

IV. STATUS OF CLAIMS

Claims 6, 19, and 20 are presented for review in the present Appeal. Claims 1 - 5 and 7 - 18 have been cancelled, and no claims have been allowed.

V. STATUS OF AMENDMENTS -

Applicant filed a Request For Reconsideration After Final Rejection on August 14, 2007. By Advisory Action dated September 18, 2007, the Examiner maintained the rejection of the claims on the same grounds set forth in the Final Action dated August 8, 2007.

VI. SUMMARY OF CLAIMED SUBJECT MATTER -

The subject matter of the Claims 6, 19 and 20 presented for review in the instant Appeal is directed to a receptacle for electronic or communications equipment mounted in standard furniture units, such as office conference tables. Referring to Figure 1 of the drawing, the top surface 8 of a table 4 has two square cutout openings 12 for receiving therein a receptacle unit designated by reference numeral 22 (See page 8 of Applicant's specification). The receptacle 22 shown towards the left side of the table top is in a recessed position in which the top surface 24 of the receptacle is coplanar with the top surface 8 of the table. However, the receptacle 22 towards the right side of the table is shown in its extended position in which the top surface 24 of the receptacle is elevated above the top surface 8 of the table, thereby providing access to four sidewalls 26 of the receptacle 22. The sidewalls carry individual receptacles 32 for receiving connecting power cords from electrical and communication equipment on the table top, as for example the computer 14 and the telephone 16. (See Applicant's specification, page 9, first full paragraph through page 10, first paragraph).

The receptacle unit 22 is itself connected to external power sources including electrical power lines and communication transmission lines (See Applicant's specification, page 11, lines 1 - 4).

When the receptacle unit 22 is in its extended position as shown to the right on the table top in Figure 1, power lines from equipment on the table top, as for example the telephone 16, are coupled to one of the individual receptacles 32 in one of the walls 26 of the receptacle unit 22. After one or more units of equipment are coupled to the receptacle unit, the receptacle is depressed into its retracted position as shown by the receptacle unit 22 to the left on the table top shown in Figure 1. A gap between the top 24 of the receptacle unit 22 and the periphery of the square shaped opening 12 defined in the table top 8 provides clearance for cords connecting equipment on the table with the receptacle unit 22 so that the receptacle unit can be depressed into its retracted position with one or more cords received in the individual receptacles 32. Releasable locking means 25 maintain the receptacle unit 22 in its retracted position, and resilient means 23 are provided for biasing the receptacle unit 22 into its extended position when the locking means are released (See Applicant's specification, page 10, first paragraph through page 11, first paragraph).

When the receptacle unit 22 is in its retracted position recessed within the opening in the table top (as shown by unit 22

to the left in Figure 1 of the drawings), the locking means 25 maintaining the receptacle unit 22 in its retracted position overcome the opposed resilient force of the biasing means 23 urging the receptacle unit 22 into its extended position. When the locking means is released, the opposed resilient force acting on the receptacle unit 22 causes the receptacle unit 22 to assume its extended position, as shown to the right on Figure 1 of the drawings.

VII. GROUND OF REJECTION TO BE REVIEWED ON APPEAL -

The following issues are presented for review in the present Appeal:

1. Whether Claims 6, 19 and 20 are unpatentable under 35 U.S.C. Section 103(a) over Cole (U.S. Patent No. 3,646,344) in view of Byrne (U.S. Patent No. 4,747,788).

VIII. ARGUMENT -

Applicant notes that Claims 6 and 19 are the only independent claims pending in the present application and presented for review in the instant Appeal. These claims have been rejected over the same combination of prior art references, and the rejection of these claims will be argued together. The rejection of dependent Claim 20 will not be separately argued. If appealed parent independent Claim 19 is allowed, appealed dependent Claim 20 will be allowable for at least the same reasons as its parent independent claim.

a). Rejection Claims 6 and 19 as being unpatentable over Cole in view of Byrne.

In support of the prior art rejections made in the Final Action dated August 8, 2007, the Examiner states that the Cole patent discloses "...means 45a, 45b for resiliently biasing the receptacle unit into said extended position, and cooperating releasable locking means 27, 37 for opposing said biasing means...". Applicant respectfully disagrees with the Examiner's conclusion regarding these elements disclosed in the Cole patent. Elements 45a and 45b of the Cole patent do not resiliently bias the receptacle unit into an extended position. On the contrary, these elements do not exert a force on the housing 10 to move it from its recessed position in the casing 16 (as shown in Fig. 1) into its extended position above the casing 16 (as shown in Fig. 4). By the express disclosure of the Cole specification, the housing 10 is moved manually from its recessed position into its extended position by a lifting handle, and there is no resilient means acting on the housing to urge it into its extended position. See the Cole specification, starting at column 4, line 73, which states:

"When the floor receptacle housing 10 is to be withdrawn from the casing 16 to its in-use position above the concrete floor, the cap 50 is rotated in a counterclockwise direction by turning a coin or a similarly shaped object positioned in the slot 53. The initial turning of the cap 50 provides for loosening the latch member 55...Latch member 55 is now free to move upwardly by the force of a spring 54 such that the bolt 51 and cap 50 pop up, as shown in Fig. 4, so as to provide a convenient handle for lifting the housing 10 out of the casing 16. [Col. 4, line 73 - Col. 5, line 16;

emphasis added].

Therefore, the housing 10 is moved into its extended position relative to the casing 16, not by a resilient bias acting on the housing, but by manual force on a handle to lift the housing 10 from the casing 16.

Elements 45a and 45b are spring-supported stops, which are oriented laterally relative to the outer sidewall of the housing. When the housing is lifted upwardly relative to the casing to a position in which elements 45a and 45b are elevated above the top of the casing, stops 45a and 45b snap outwardly onto a flange 27 to support the housing in its extended position. Thus, elements 45a and 45b do not urge the housing into its extended position, but on the contrary, elements 45a and 45b only retain the housing in its extended position after the housing has been manually lifted from the recess by the lifting handle. The Cole specification, starting at Column 5, line 17 expressly states:

"As described previously, the housing 10 is lifted until gasket 31 on bottom cover plate 30 bears against the bottom end of casing 16 at which time the spring-supported stops 45a and 45b snap out into flange 27 to support the housing 10 in its withdrawn position..." [Col. 5, lines 17 - 21].

Thus, the spring-supported stops 45a and 45b of the Cole device do not resiliently bias the housing into its extended position, but on the contrary, serve a completely different

function - these elements retain the housing in its extended position, against gravitational forces, relative to the casing only after the housing has been fully lifted a predetermined distance above the casing.

When the housing is to be returned to its recessed position in the casing, stops 45a and 45b are pressed inwardly, and the housing is then manually lowered back into the casing into its recessed position. The Cole specification, starting at Col. 5, line 21, expressly states:

"...When it is desired to again position the housing into its recessed position in the floor, the stops 45a and 45b can be pressed inwardly and the housing 10 is then lowered down into the casing 16 while being held by cap 50..." [Col. 5, lines 21 - 24].

Applicant respectfully submits that it is clear from the disclosure of the Cole specification that elements 45a and 45b are not means for resiliently biasing the housing into its extended position relative to the casing, but on the contrary, are stops or retaining means for retaining the housing in its extended position against gravitational forces acting thereon, only after the housing has been manually lifted from the casing. As noted above, the stops 45a and 45b are movable only in a direction transverse or lateral to the direction of the housing relative to the casing, and therefore cannot exert a resilient

bias on the housing urging it into its extended position relative to the casing.

The Final Action also states that the Cole patent discloses "cooperating releasable locking means 27, 37 for opposing said biasing means". Applicant respectfully disagrees with this conclusion. Element 27 of the Cole patent is a flange which cooperates with the stops 45a and 45b to retain the housing in its extended position after the housing is manually lifted from the casing. Flange 27 is defined on a trim ring 37 (See Col. 4, lines 15 - 16). The Cole specification expressly discloses, starting at Col. 5, lines 17 - 21:

"As described previously, the housing 10 is lifted until gasket 30 on bottom cover plate 30 bears against the bottom end of casing 16 at which time the spring-supported stops 45a and 45b snap out into flange 27 to support the housing 10 in its withdrawn position..." [Col. 5, lines 17 - 21, emphasis added].

Therefore, elements 27, 37 of the Cole device do not provide releasable locking means to maintain the housing in the casing, opposing a resilient bias, as disclosed and claimed by Applicant. On the contrary, elements 27, 37 of the Cole device are provided for a totally different function - to retain the housing in its extended position relative to the casing after the housing has been manually lifted from the casing, and not to oppose the force on the housing urging it into its extended position.

Applicant respectfully submits that the stops 45a and 45b disclosed in the Cole specification do not provide means for resiliently biasing the receptacle into an extended position, as disclosed and expressly claimed by Applicant, and that the Cole specification does not disclose cooperating releasable locking means for opposing the means for resiliently biasing and maintaining the receptacle unit in a retracted position, as disclosed and expressly claimed by Applicant. On the contrary, stops 45a and 45b disclosed by Cole do not exert a resilient bias on the housing 10 urging it into its extended position relative to the casing 16, and the elements 27, 37 do not provide releasable locking means opposing any bias urging the housing into its extended position relative to the casing. By the express disclosure of the Cole specification, the housing 10 is manually lifted into its extended position relative to the casing, and the stops 45a and 45b cooperate with elements 27, 37 to retain the housing in its extended position (and not to retain the housing in its recessed position within the casing), as disclosed and expressly claimed by Applicant.

Although not addressed in the Final Action, it is noted that neither spring 54 which acts upon the latch member 55, or spring 60 which is disposed around the bolt 51, (as discussed at Column 5, lines 2 - 17 of the Cole specification) provides means for resilient biasing the housing 10 into its extended position relative to the casing 16. On the contrary, the springs 54 and 60 provide means for moving a handle (latch 55, bolt 51 and cap

50) into an extended position relative to the housing 10, but do not provide a resilient bias on the housing 10 itself into an extended position relative to the casing. On the contrary, the housing 10 must be manually moved relative to the casing 16 only after the handle is provided by the extended bolt 51 and cap 50. The Cole specification, by its own terms, expressly states that the bolt 51 and the cap 50 pop up as shown by Figure 4, "so as to provide a convenient handle for lifting the housing 10 out of the casing 16" (Column 5, lines 16 - 17 of the Cole specification).

Applicant respectfully submits that a combination of the Cole and Byrne patents does not teach or suggest independent Claim 6, when viewed as a whole, since neither Byrne or Cole disclose or suggest means for resiliently biasing a receptacle unit into an extended position, as expressly recited in independent Claim 6. Moreover, since neither Byrne or Cole disclose means for resiliently biasing a receptacle unit into an extended position, neither of these patents teaches or suggests cooperating locking means for opposing resilient biasing means. As noted above, elements 45a and 45b disclosed by Cole are stops for retaining the housing 10 in its extended position relative to the casing 16, and are not releasable locking means "for retaining said receptacle unit in said retracted position", as expressly recited in independent Claim 6. On the contrary, the stop 45a and 45b act exactly opposite to that claimed - their purpose is to retain the housing 10 in its extended (not retracted) position relative to the casing 16.

Applicant respectfully submits that independent Claim 6 is clearly allowable over the prior art applied in the Final Action. Independent Claim 19, which includes the features of independent Claim 6, is allowable over the prior art applied in the Final Action for the same reasons discussed above the respect to independent Claim 6. Dependent Claim 20, which depends from independent Claim 19, is allowable at least for the same reasons as parent independent Claim 19.

Independent Claims 6 and 19 expressly recite "means for resiliently biasing said receptacle unit into said extended position", and "cooperating releasable locking means for opposing said means for resiliently biasing for retaining said receptacle unit in said retracted position". As discussed herein, the Cole specification does not teach or suggest either of these two features expressly recited in independent Claims 6 and 19. Therefore, a combination of Cole and Byrne, as proposed in the Final Action dated August 8, 2007, does not teach or suggest independent Claims 6 and 19 when all positively recited features of these claims are considered in the patentability determination.

It is well established that references cannot be combined to reject a claim unless there is a suggestion or motivation in the prior art itself or within the general knowledge in the art to make the combination. It is also well established that it is improper to use an Applicant's own disclosure as a guide for

combining the right references in the right way to reconstruct an Applicant's claims. See, for example, Orthopedic Equipment Co. v. United States, 217 USPQ 193 (Fed. Cir. 1983); Micro-Chemical, Inc. v. Great Plains Chemical Co., Inc., 41 USPQ 2d 1238 (Fed. Cir. 1997); In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992); and KSR International Co. v. Teleflex Inc., 82 USPQ 2d 1385 (US Sup. Ct. 2007).

In the instant case, the Cole patent, which was cited as disclosing means for resiliently biasing a housing into an extended position, does not teach or suggest this feature of the claimed invention. Cole was also cited as disclosing releasable locking means overcoming the means for resiliently biasing a housing to maintain the housing in a retracted position, yet Cole does not teach or suggest this additional feature of the claimed invention. Accordingly, since Cole does not teach or suggest two significant features of the invention which are expressly recited in both appealed independent Claim 6 and 19, a combination of Cole with Byrne can not teach or suggest the invention defined by independent Claims 6 and 19 to a person of ordinary skill in the relevant art at the time the invention was made, when all positively recited features of these claims are considered .

IX. CONCLUSION -

Applicant respectfully submits that independent Claims 6 and 19 are allowable over the prior art applied in the Final Action dated August 8, 2007. The remaining dependent Claim 20 is allowable, at least for the same reasons as its respective parent independent Claim 19.

The rejection of Claims 6, 19 and 20 made by the Primary Examiner in the Official Action dated August 8, 2007 should be reversed by the Board.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Mark P. Stone', with a stylized flourish at the end.

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APPENDIX OF APPEALED CLAIMS

Claim 6. An article of furniture having a top surface and an opening defined in said top surface; the improvement comprising a receptacle unit adapted to be mounted in said opening in said top surface of said article of furniture; said receptacle unit comprising a top and at least one sidewall extending downwardly from said top, said at least one sidewall having at least one receptacle defined therein; and means for selectively displacing said receptacle unit between a retracted position in which said top of said receptacle unit is planar with said top surface of said article of furniture, and an extended position in which said at least one receptacle in said at least one sidewall of said receptacle unit is elevated above the top surface of said article of furniture,

said improvement further including means for resiliently biasing said receptacle unit into said extended position, and cooperating releasable locking means for opposing said means for resiliently biasing for retaining said receptacle unit in said retracted position.

Claim 19. An article of furniture having a top surface and an opening defined in said top surface; a receptacle unit mounted in said opening in said top surface; said receptacle unit comprising a top and at least one sidewall extending downwardly from said top, said at least one sidewall having at least one

receptacle defined therein; means for selectively displacing said receptacle unit between a retracted position in which said top of said receptacle unit is planar with said top surface of said article of furniture, and an extended position in which said at least one receptacle in said at least one sidewall of said receptacle unit is elevated above the top surface of said article of furniture; and a housing mounted to an underside of said top surface of said article of furniture, said housing having an open top and being aligned with said opening defined in said top surface of said article of furniture so as to receive said receptacle unit in said housing when said receptacle unit is in said retracted position, said article of furniture further including means for resiliently biasing said receptacle unit into said extended position, and cooperating releasable locking means for opposing said means for resiliently biasing for retaining said receptacle unit in said retracted position.

Claim 20. The article of furniture as claimed in Claim 19 wherein said housing includes means for coupling said receptacle unit to an external power source.

EVIDENCE APPENDIX

NONE

COPIES OF PROCEEDINGS ON PETITION

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: David G. McCarthy

Serial No. 08/951,276

Filed: October 16, 1997

Title: Retractable Receptacle
For Furniture

Commissioner for Patents
Washington, D.C. 20231

Attn: Box DAC
Office of Petitions

PETITION TO COMMISSIONER UNDER 37 CFR 1.181

I). INTRODUCTION

The above identified Applicant, by and through his undersigned attorney, hereby petitions the Commissioner under 37 CFR 1.181 to invoke his supervisory authority and vacate the decision in the Official Action dated March 7, 2003 by the Primary Examiner, the Supervisory Patent Examiner, and the Director of Technology Center 2800, re-opening prosecution of this application on the merits under 37 CFR 1.198 after decision by the Board of Patent Appeals & Interferences.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner of Patents & Trademarks, Washington, D.C. 20231, on April 10, 2003
(Date of Deposit)

Mark P. Stone
MARK P. STONE

Reg. No. 27,954

As more fully discussed herein, the re-opening of prosecution on the merits fails to comply with the express requirements set forth in 37 CFR 1.198.

II). STATEMENT OF FACTS

1). In a final action dated August 31, 1999, the Primary Examiner rejected Claims 1, 2, 6 and 16 under 35 U.S.C. Section 102(b) over the Byrne patent (U.S. Patent No. 4,747,788); rejected Claims 19 and 20 under 35 U.S.C. Section 102(b) over the Mitchell et al patent (U.S. Patent No. 4,511,198); and rejected Claims 3 - 5, 7 - 15 and 17 - 18 under 35 U.S.C. Section 103(a) over the Byrne patent (U.S. Patent No. 4,747,788). No claims were allowed.

2). On November 1, 1999, Applicant filed a Request For Reconsideration After Final Rejection;

3). In an Advisory Action dated November 16, 1999, the Examiner maintained the prior art rejection of the claims;

4). On December 2, 1999, Applicant filed a Notice of Appeal. Applicant's Appeal Brief which, inter alia, presented arguments rebutting the prior art rejections in the final action, was filed on January 19, 2000;

5). In the Examiner's Answer dated April 11, 2000, all prior art rejections were withdrawn. Paragraph 6 of the Examiner's Answer expressly states: "The appellant's statement of the issues in the brief is correct; the rejections under 35 USC 102 and 103 are withdrawn.";

6). On October 31, 2002, the Board of Patent Appeals And Interferences reversed all outstanding grounds of rejection under 35 U.S.C. 112 raised against appealed Claims 1 - 20; and

7). In an Official Action dated March 7, 2003, the Examiner re-opened prosecution on the merits and rejected all of the appealed Claims 1 - 20 over the same two prior art references (U.S. Patent Nos. 4,747,788 and 4,511,198) which were applied in the final rejection dated August 31, 1999, and which were expressly withdrawn from the appeal in the Examiner's Answer dated April 11, 2000.

III). ARGUMENT -

37 CFR 1.198 states:

"Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of Section 1.114 or Section 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown".

Applicant submits, based upon the facts set forth above, that the Examiner lacked authority under 37 CFR 1.198 to re-open prosecution on the merits after appeal and to apply the same prior art references expressly withdrawn by the Examiner in the Examiner's Answer prior to the decision on appeal.

37 CFR 1.198 imposes two requirements on cases re-opened after decision by the Board, namely, 1). that the case can be re-opened only for the consideration of matters not already adjudicated, and 2). that sufficient cause for re-opening prosecution be shown.

In the instant case, the Examiner has re-opened the prosecution for consideration of matters which have already been adjudicated by the Board. The express withdrawal of all prior art rejections in the Examiner's Answer based upon the two prior art patents applied in the final rejection, after Applicant had argued against these prior art rejections in his Appeal Brief, constitutes an adjudication of these rejections in Applicant's favor by default. Although the March 7, 2003 Official Action applies the same two prior art patents in a different manner than they were applied in the final rejection, the current rejections are nonetheless based on the identical prior art patents withdrawn by the Examiner during appeal. The Examiner had the authority to re-open prosecution to withdraw the prior art rejections in the final action based on the arguments advanced in Applicant's Appeal Brief and enter a new ground of rejection

applying the two prior art patents in a different manner prior to the Board's decision on appeal (Manual of Patent Examining Procedure, 8th Edition, August 2001, Section 1208.02), but elected not to do so.

The withdrawal in the Examiner's Answer of the prior art rejections based on the two prior art patents applied in the final action in response to the arguments advanced in Applicant's Appeal Brief, and the failure by the Examiner to enter any new grounds of rejection based on these two patents prior to the decision on appeal, results in an adjudication in Applicant's favor, by default, that the appealed Claims 1 - 20 define patentable subject matter over these two prior art patents. The Official Action dated March 7, 2003, rejecting the same appealed claims over the same two prior art patents withdrawn in the Examiner's Answer, is therefore directed to matters already adjudicated by the decision on appeal, and prosecution on the merits cannot be re-opened under 37 CFR 1.198 to address these matters.

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The Official Action dated March 7, 2003 fails to show sufficient cause for re-opening prosecution on the merits, as expressly required by 37 CFR 1.198. In fact, the Official Action does not even address the issue of sufficient cause, nor acknowledge that the rejections being made are based upon the two

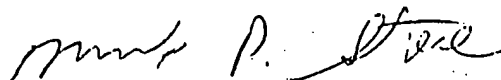
identical prior art patents applied in the final action and thereafter expressly withdrawn in the Examiner's Answer during the appeal. The Examiner was clearly aware of the existence of the two prior art references applied in the March 7, 2003 Official Action before the decision of the Board on appeal and, as discussed above, could have re-opened prosecution on the merits to apply these two prior art patents in the manner applied in the March 7, 2003 Official Action prior to the Board's decision. Yet, the Official Action fails to make any showing or provide any explanation as to why the two prior art patents applied in the March 7, 2003 Official Action were not, or could not have been, applied by the Examiner to make the rejections first made in the March 7, 2003 Official Action before the decision by the Board on the appeal. Therefore, the Examiner has failed to make a sufficient showing for re-opening of prosecution on the merits after decision on appeal, as required by 37 CFR 1.198.

IV). CONCLUSION -

Applicant submits that the Official Action dated March 7, 2003, re-opening the prosecution after decision by the Board on appeal, fails to comply with the requirements of 37 CFR 1.198,

and requests that the Examiner be directed to withdraw the prior art rejections of the claims made in the Official Action dated March 7, 2003.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Mark P. Stone", with a stylized flourish at the end.

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Paper No. 21

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NOV 19 2003

In re Application of:
David G. McCarthy
Serial No.: 08/951,276
Filed: October 16, 1997
Attorney Docket No.: 402-038-19

DECISION ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.181, filed on April 15, 2003.

The petition is DENIED.

The petitioner requests that the decision in the Official Action dated March 7, 2003 be vacated.

A review of the record indicates that the Board of Patent Appeals and Interferences (BPAI) only adjudicated the matter of the rejection under 35 USC §112, 1st paragraph. The BPAI never adjudicated the rejection of the claims over prior art.

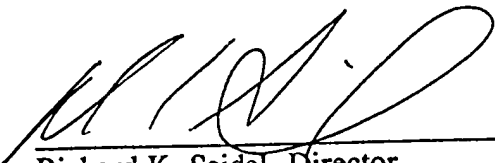
While the art rejection was withdrawn prior to the decision by the BPAI, no where in the record is it indicated that the claims were allowable over the prior art of record.

The Examiner has reopened prosecution and properly rejected the claims on new grounds, albeit using the same prior art, as pointed out by the petitioner. 37 CFR 1.198 states "Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of 37 CFR 1.114 or 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown." It is our contention that the new grounds of rejection under 35 USC §103 show sufficient cause to warrant the reopening of prosecution.

Accordingly, the petition is denied.

- Inquiries regarding this decision should be directed to Paula Bradley at (703) 308-2319.

The case will be forwarded to Examiner Hammond.

A handwritten signature in dark ink, appearing to read 'R. K. Seidel', is written over a horizontal line.

Richard K. Seidel, Director
Technology Center 2800
Semiconductors, Electrical and
Optical Systems, and Components

402-038-19

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: David G. McCarthy : Examiner B. Hammond
Serial No. 08/951,276 : Group Art Unit: 2833
Filed: October 16, 1997 :
Title: Retractable Receptacle :
For Furniture :

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

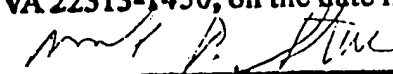
Attn: Box DAC
Office of Petitions

REQUEST FOR RECONSIDERATION OF DECISION
ON PETITION BY TECHNOLOGY CENTER DIRECTOR

The above identified Applicant, by and through his undersigned attorney, hereby requests review of the Decision On Petition dated November 19, 2003 (copy enclosed), by the Director of Technology Center 2800.

On April 15, 2003, a Petition to Commissioner Under 35 CFR 1.181 (copy enclosed) was filed requesting that the decision in the Official Action dated March 7, 2003, to re-open prosecution on the merits after appeal, be vacated. As more fully discussed

I hereby certify that this correspondence is
being deposited with the United States Postal Service
as first class mail in an envelope addressed to
Commissioner for Patents, P.O. Box 1450, Alexandria,
VA 22313-1450, on the date indicated below.


MARK P. STONE
Reg. No. 27,954

12/9/03
(Date of Deposit)

in the Petition filed on April 15, 2003, Applicant filed a Notice of Appeal in response to a final rejection by the Primary Examiner dated August 31, 1999, raising both prior art and formal grounds of rejection. Applicant's Appeal Brief addressed both the prior art and the formal grounds of rejection, and the Examiner's Answer expressly withdrew the prior art grounds of rejection. The Board of Patent Appeals And Interferences reversed the formal grounds of rejection but the Examiner re-opened prosecution on the merits raising prior art rejections based upon the same prior art references applied in the final rejection dated August 31, 1999.

In the Petition filed on April 15, 2003, Applicant argued that the re-opening of the prosecution on the merits after appeal to reject the appealed claims on prior art known to and applied by the Examiner prior to the Appeal, where all prior art rejections made prior to the filing of the appeal were expressly withdrawn by the Examiner, violates 37 CFR 1.198 because 1). the grounds of prior art rejection raised by the Primary Examiner in the reopened prosecution have already been adjudicated by the Board (by default), and 2). because the Primary Examiner has failed to show good cause why prosecution should now be reopened to reject claims over identical prior art known to the Examiner prior to the filing of the appeal and expressly withdrawn by the Examiner prior to decision by the Board, as are more fully addressed at Section III, starting at page 3 of Applicant's Petition filed on April 15, 2003.

The Decision on Petition dated November 19, 2003, states that the Board only adjudicated the formal grounds of rejection, and never adjudicated the rejection of the claims over the prior art. However, this occurred only because the Examiner expressly withdrew the prior art rejections in the Examiner's Answer prior to the decision on appeal, but allowed the appeal to proceed based only on the formal grounds of rejection.

The Decision On Petition states "...no where in the record is it indicated that the claims were allowable over the prior art of record." Applicant respectfully disagrees. The fact that the Examiner withdrew all prior art rejections in the Examiner's Answer (in response to the arguments advanced by Applicant in the Appeal Brief that the claims are allowable over the prior art applied in the final action), and that the Examiner allowed the appeal to proceed based only on the formal grounds of rejection is, at the least, an implicit admission that the Examiner considered the appealed claims to be allowable over the prior art of record.

The Decision On Petition dated November 19, 2003, also states that "...the new grounds of rejection under 35 U.S.C. Section 103 show sufficient cause to warrant the reopening of prosecution". However, the Decision On Petition fails to provide any explanation why the new grounds of rejection, which are based upon the identical prior art references cited and applied in the Final Action dated August 31, 1999, were not made by the Examiner

prior to Decision by the Board on Appeal, particularly when the Examiner expressly withdrew all prior art rejections in the Final Action but allowed the Appeal to proceed based only on the formal grounds of rejection.

Applicant respectfully submits, for the reasons addressed in the Petition filed on April 15, 2003, that the reopening of prosecution on the merits after decision by the Board for the purpose of raising prior art rejections based on the identical prior art references applied by the Examiner prior to the Appeal, which were expressly withdrawn by the Examiner prior to the decision by the Board, violates 37 CFR 1.198.

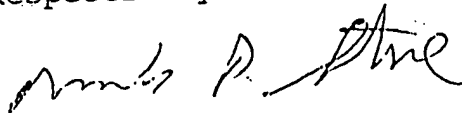
Applicant respectfully requests reconsideration and reversal of the Decision On Petition, dated November 19, 2003, denying Applicant's Petition filed on April 15, 2003.

Enclosed are copies of Petition filed on April 15, 2003, and the Decision On Petition dated November 19, 2003.

Also enclosed is a notice of Change of Attorney's Correspondence Address. Please forward all further

correspondence regarding this patent application to the address indicated on the enclosed notice.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Mark P. Stone", written in a cursive style.

Mark P. Stone
Reg. No. 27,954
Attorney for Applicant
25 Third Street, 4th Floor
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OCT 05 2004

OFFICE OF PETITIONS

In re Application of:
David G. McCarthy
Application No.: 08/951,276
Filed: October 16, 1997
For: RETRACTABLE RECEPTACLE FOR
FURNITURE

DECISION ON
PETITION

This is a decision on the petition under 37 CFR 1.181(a)(3) filed on December 11, 2003, invoking the supervisory authority of the Director to review the decision of the Group Director of Technology Center 2800 (Group Director), which decision refused to vacate the reopening of prosecution subsequent to the decision of the Board of Patent Appeals and Interferences.

The petition under 37 CFR 1.181(a)(3) to vacate the reopening of prosecution subsequent to the decision of the Board of Patent Appeals and Interferences is **DENIED**.

BACKGROUND

The final rejection of August 31, 1999, included: (1) a rejection of claims 1 through 20 under 35 U.S.C. § 112, first paragraph as containing subject matter not described in the specification; (2) a rejection of claims 1, 2, 6, and 16, as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 4,747,788; (3) a rejection of claims 19 and 20 as anticipated by U.S. Patent No. 4,511,198; and (4) a rejection of claims 3 through 5, 7 through 16, and 17, 18 under 35 U.S.C. § 103(a) over U.S. 4,747,788.

On December 2, 1999, applicant filed a notice of appeal, followed on January 19, 2000 by applicant's brief on appeal. On April 11, 2000, the examiner's answer was mailed. The examiner's answer expressly withdrew the grounds of rejection under 35 U.S.C. §§ 102, 103, but maintained the rejection under 35 U.S.C. § 112, first paragraph.

On October 31, 2002, the Board of Patent Appeals and Interferences issued a decision that noted (at 2) that the rejections under 35 U.S.C. §§ 102, 103 had been withdrawn by the examiner, and reversed the rejection of claims 1 through 20 under 35 U.S.C. § 112 first paragraph.

On March 7, 2003, an Office action was mailed which reopened prosecution by re-applying the prior art references that had been previously employed in the final rejection and then withdrawn in the examiner's answer. The Office action (at 7) was signed, *inter alia*, by the Group Director.

On April 15, 2003 applicant filed a petition seeking that the reopening of prosecution by the Office action of March 7, 2003, be vacated on the grounds that such lacked compliance with 37 CFR 1.198. On December 11, 2003, the Group Director denied the petition on the grounds that the contested reopening was authorized under the terms of 37 CFR 1.198.

The instant petition was filed December 11, 2003.

REGULATION AND EXAMINING PROCEDURE¹

37 CFR 1.198 provides that:

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

MPEP 1214.04 states in pertinent part:

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP § 1002.02(c) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution.

¹ Manual of Patent Examining Procedure ("MPEP") (8th ed 2001) (Rev. 2, May 2004)

DECISION

Petitioner contends that as the examiner had withdrawn all rejections of the claims over the same prior art references, coupled with the fact that the examiner permitted the appeal to be decided only on the formal grounds *i.e.*, the rejection based on 35 U.S.C. § 112, first paragraph, "is at the least, an implicit admission" by the examiner that the claims are considered allowable over that prior art. Petitioner further complains that the decision fails to provide any explanation why the current grounds of rejection were not made by the examiner prior to the decision by the Board of Patent Appeals and Interferences (BPAI). Petitioner further contends that the re-application of the previously applied, and withdrawn, references, "violates 37 CFR 1.198."

While it is unfortunate that the examiner did not present the current rejections over the same prior art references, such that the BPAI could have all issues before it when the decision of October 31, 2002 was rendered, the reopening of prosecution herein is neither improper under nor inconsistent with 37 CFR 1.198.

The record shows that the prior art-based rejections in the final Office action of August 31, 1999 were not carried forward into the examiner's answer of April 11, 2000. Therefore, the BPAI treated the prior art-based rejections as withdrawn and not before the BPAI for review. See Ex parte Emm, 118 USPQ 180, 181 (Bd. Pat. App. 1957).² The instant situation is akin to the situation in In re Freeman, 166 F.2d 178, 76 USPQ 585 (CCPA 1948), in which: (1) the examiner rejected claims in the application on the basis of (*inter alia*) double patenting; (2) the double patenting rejection was withdrawn by the examiner before the application was forward to the Board of Appeals for a decision on the remaining rejections; (3) the Board of Appeals sustained the rejection of some claims but reversed the rejection of other claims; and (4) the examiner obtained approval to reopen prosecution for the purpose of rejecting claims in the application on the basis of (*inter alia*) double patenting. In response to arguments similar to those being made by petitioner, the CCPA indicated that the fact that the examiner withdrew the double patenting rejection prior to the initial appeal does not preclude the examiner from reopening prosecution (upon obtaining the appropriate approval) and rejecting the claims on the basis of double patenting. See Freeman, 166 F.2d at 179-80, 76 USPQ at 586. Therefore, that the examiner withdrew the prior art-based rejections in the final Office action of August 31, 1999 does not preclude the examiner from obtaining approval to reopen prosecution under 37 CFR 1.198 for the purpose of entering the previously withdrawn prior art based rejections of the claims.

The authority to permit the reopening of prosecution subsequent to a decision by the BPAI under 37 CFR 1.198 has been delegated to the Group Director. See MPEP 1002.02(c), ¶ 1. The Office action that reopened prosecution was signed by the Group Director, thus indicating that the

² Inasmuch as the prior art-based rejections were not before the BPAI for review, these rejections have not already been adjudicated by the BPAI, by "default" or otherwise.

Group Director approved the examiner's request to reopen prosecution in the above-identified application. It is well established that if there is any substantial, reasonable ground within the knowledge or cognizance of the Director why the application should not issue, the Director has the duty, much less the authority, to refuse to issue the application. See In re Drawbaugh, 9 App. D.C. 219, 240 (D.C. Cir 1896). The questions of patentability set forth in the Office action of March 7, 2003 are "sufficient cause" for reopening prosecution in the above-identified application under 37 CFR 1.198.

CONCLUSION

The instant petition is granted to the extent that the decision of the Group Director has been reviewed, but is denied as to making any change therein. As the reopening of prosecution in the above-identified application was consistent with 37 CFR 1.198, the Group Director's refusal to vacate the reopening of prosecution subsequent to the decision of the Board of Patent Appeals and Interferences will **not** be disturbed.

Telephone inquiries concerning this decision may be directed to Petitions Examiner Brian Hearn at (571) 272-3217.



Stephen G. Kunin
Deputy Commissioner
for Patent Examination Policy

RELATED PROCEEDINGS APPENDIX

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID G. MCCARTHY

Appeal No. 2001-0076
Application 08/951,276¹

ON BRIEF

MAILED

OCT 31 2002

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before BARRETT, GROSS,¹ and LEVY, Administrative Patent Judges.
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-20.

We reverse.

¹ Application for patent filed October 16, 1997, entitled "Retractable Receptacle for Furniture."

Appeal No. 2001-0076
Application 08/951,276

BACKGROUND

The invention relates to a retractable receptacle for electronic or communications equipment mounted in a furniture unit, such as office conference tables.

No prior art is relied on in the rejection.

Claims 1-20 stand rejected under 35 U.S.C. § 112, first paragraph, based on a lack of written description. The statement of the final rejection is as follows (Paper No. 8, p. 3):

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is a lack of written description for the following; "means for coupling said housing", means for resiliently biasing; "means" for selectively displacing the receptacle unit; the "open top" of the housing; means for biasing the receptacle unit, locking means. And it is also unclear how the covering means are mounted to the top of the receptacle unit and carried by the receptacle unit as it is being displaced.

The rejections under 35 U.S.C. §§ 102 and 103 have been withdrawn.

We refer to the final rejection (Paper No. 8) (pages referred to as "FR__") and the examiner's answer (Paper No. 13) (pages referred to as "EA__") for a statement of the examiner's position, and to the reply brief (Paper No. 14) (pages referred to as "RBr__") for a statement of appellant's arguments thereagainst.

OPINION

The examiner states in the examiner's answer that the rejection is based on a lack of written description under 35 U.S.C. § 112, first paragraph, not on a lack of enablement (EA3). For this reason, appellant's arguments in the appeal brief (Paper No. 12) to enablement are moot and we refer to the written description arguments in the reply brief (Paper No. 14). However, we note that appellant was correct in interpreting the examiner's rejection as based on lack of enablement instead of lack of written description. The statement of the rejection, that the claims contain "subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention" (FR3), is clearly directed to lack of enablement, as evidenced by the words "enable" and "make and/or use the invention." The reference to "written description" after the statement of the rejection can be interpreted to refer to an insufficient written description to enable the person of ordinary skill in the art to make and use the invention and does not recast the statement of the rejection into one based on a lack of written description. If the examiner had been more careful in stating the rejection, appellant could have responded to the rejection in the brief and would not have

Appeal No. 2001-0076
Application 08/951,276

been put to the time and expense of writing a reply brief and, perhaps, this appeal would have been avoided altogether.

The written description rejection under 35 U.S.C. § 112, first paragraph, is used to reject when a claim is amended to recite elements thought to be without support in the original disclosure. In re Rasmussen, 650 F.2d 1212, 1214-15, 211 USPQ 323, 326 (CCPA 1981). "Satisfaction of the description requirement insures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that the prima facie date of invention can fairly be held to be the filing date of the application." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991), citing In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 623 (CCPA 1973).

It would have been helpful if the examiner's statement of the rejection had pointed to the claims in which the limitations which are said to be without written description support are contained. We agree with appellant's discussion (RBr3) that the "means for coupling said housing" in the rejection must be intended to refer to "said housing includes means for coupling said receptacle unit to an external power source" in claim 20. The "means for resiliently biasing" and "means for biasing the receptacle unit" in the rejection must both refer to the "means for resiliently biasing said receptacle unit" in claim 6. The

"means" for selectively displacing the receptacle unit" in the rejection must refer to the "means for selectively displacing said receptacle unit" in claims 1, 16, and 19. The "'open top' of the housing" in the rejection must refer to "a housing . . . , said housing having an open top" in claim 19. The "locking means" in the rejection must refer to the "cooperating releasable locking means" in claim 6.

Appellant shows exactly where the disputed limitations are supported in the specification (RBr3-4). We completely agree with appellant. Moreover, there is absolutely no basis for a lack of written description rejection since each of these limitations was in the originally filed claims. We are not prescient and do not know whether the examiner had some other, unexplained, rationale for rejecting the claims.² Thus, the

² We might guess that the examiner bases the rejection on a lack of written description of structure supporting the "means" limitations, except that not all of the noted limitations are in "means" format. To the extent this is the examiner's unexpressed rationale, we note that 35 U.S.C. § 112, sixth paragraph, recites that mean-plus-function language "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof" (emphasis added). "The emphasized language does not add any additional description requirement to that set forth in the first paragraph of the section." In re Knowlton, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973); In re Comstock, 481 F.2d 905, 908, 178 USPQ 616, 618 (CCPA 1973) (As indicated in Knowlton, "the third [now sixth] paragraph of § 112 does not impose a separate requirement that an invention claimed in 'means-plus-function' form must be described apart from the description requirement expressed in the first paragraph of that section."). The Federal Circuit's decision in In re Dossel, 115 F.3d 942, 42 USPQ2d 1881 (Fed. Cir. 1997) does not address these cases.

Appeal No. 2001-0076
Application 08/951,276

rejection of claims 1-20 based on lack of written description for these limitations is reversed.

The rejection further states (FR3): "it is also unclear how the covering means are mounted to the top of the receptacle unit and carried by the receptacle unit as it is being displaced." This does not appear to be a written description rejection because it questions "how" something is done and we do not find where "covering means" are claimed. This statement is not addressed by appellant. Nevertheless, the rejection is without merit. To the extent the examiner is referring to "said receptacle unit having a top," as recited, for example, in claim 1, this was part of originally filed claim 1 and cannot lack written description. The rejection of claims 1-20 based on lack of written description for this reason is reversed.

Appeal No. 2001-0076
Application 08/951,276

CONCLUSION

The rejection of claims 1-20 is reversed.

REVERSED

Lee E. Barrett

LEE E. BARRETT
Administrative Patent Judge

Anita Pellman Gross

ANITA PELLMAN GROSS
Administrative Patent Judge

Edward A. Leroy

STUART S. LEVY
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
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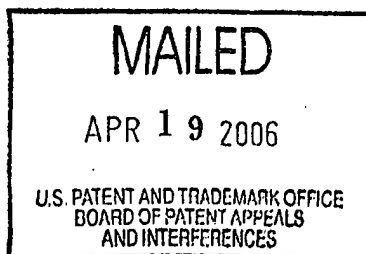
Appeal No. 2001-0076
Application 08/951,276

MARK P. STONE
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STAMFORD, CT 06905

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte DAVID G. MCCARTHY

Appeal No. 2006-0159
Application 08/951,276¹

ON BRIEF

Before BARRETT, GROSS, and LEVY, Administrative Patent Judges.
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-20.

We affirm-in-part.

¹ Application for patent filed October 16, 1997, entitled "Retractable Receptacle for Furniture."

PRIOR DECISION

A prior decision was entered by this panel in Appeal No. 2001-0076 on October 31, 2002, in which we reversed the examiner's rejection under 35 U.S.C. § 112, first paragraph, for lack of written description. In that case, the examiner had expressly withdrawn the rejections under 35 U.S.C. §§ 102 and 103 in the examiner's answer, so no prior art rejections were before us. The examiner has obtained permission to reopen prosecution after the Board decision.

BACKGROUND

The invention relates to a retractable receptacle for electronic or communications equipment mounted in a furniture unit, such as office conference tables.

Claim 1 is reproduced below:

1. In an article of furniture having a top surface and an opening defined in said top surface; the improvement comprising a receptacle unit adapted to be mounted in said opening in said top surface of said article of furniture; said receptacle unit comprising a top and at least one sidewall extending downwardly from said top, said at least one sidewall having at least one receptacle defined therein; and means for selectively displacing said receptacle unit between a retracted position in which said top of said receptacle unit is planar with said top surface of said article of furniture, and an extended position in which said at least one receptacle in said at least one sidewall of said receptacle unit is elevated above the top surface of said article of furniture.

THE REFERENCES

The examiner relies upon the following references:

Mitchell et al. (Mitchell)	4,511,198	April 16, 1985
Byrne	4,747,788	May 31, 1988

Mitchell discloses a pop-up receptacle unit in a housing mounted to an underside of a top surface of a piece of furniture in relation to an opening in the surface. The receptacle unit is spring biased and is held in either a retracted or extended position (Figs. 2 and 3). The opening 14 is formed with a recessed annular shoulder 16 so that a thin closure disk (not shown) can be placed thereon to provide an uninterrupted working surface 12 (col. 3, lines 64-68; Fig. 2). Only one receptacle is shown (Fig. 4), but it is disclosed that the housing 50 has receptacle openings at each side thereof (col. 4, lines 41-44).

Byrne discloses a manually operable retractable receptacle in a slot 102 in the top of a furniture work surface 104 having a veneer 106. A stationary upper housing 108 has vertical sides 112 and 114 and a horizontal collar 116 (col. 6, lines 53-62). The collar 116 overhangs the slot 102 with the lower surface of the collar 116 substantially flush with the veneer 106 to support the housing 108 (col. 7, lines 8-13). The power carriage 150 has a receptacle box 152 with a pair of receptacles 170 on one side and an upper cover plate 162 which fits essentially flush with the collar 116 when the receptacle box 152 is in the closed position (col. 8, line 65, to col. 9, line 1). A separate cover

plate 164 can be provided to cover part of the opening not covered by cover plate 162 and there can be a power cord opening 166 which may be covered with a set of flexible brushes 168 (Fig. 2; col. 9, lines 3-29). Byrne discloses that the receptacle box 152 could be double-sided (col. 9, lines 54-59).

We refer to the final rejection (pages referred to as "FR__") entered November 18, 2004, and the examiner's answer (pages referred to as "EA__") entered June 14, 2005, for a statement of the examiner's rejection, and to the appeal brief (pages referred to as "Br__") received March 3, 2005, and the reply brief (pages referred to as "RBr__") received June 23, 2005, for a statement of appellant's arguments thereagainst.

THE REJECTIONS

Claims 1-5 and 7-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Byrne and Mitchell. The examiner finds that Byrne discloses the top 162 of the receptacle "being 'substantially' planar with a top surface of the article of furniture (see col.7, lines 10-12)" (FR2), but not "planar." The examiner finds that Mitchell teaches a receptacle unit mounted in a housing on an underside of the top surface with a disk in a recess to provide an uninterrupted working surface and concludes that it would have been obvious "to modify the receptacle of Byrne by having the top of the receptacle being planar with a top

surface of the article of furniture so that the surfaces would be flush as taught by Mitchell et al." (FR3).

Claims 1, 2, 4-7, 10, 12-15, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell. The examiner finds that Mitchell discloses the claimed invention except for the top of the receptacle unit being planar with a top surface of the article of furniture. The examiner finds that Mitchell teaches a disk in a recess to cover the receptacle unit to provide an uninterrupted working surface and that it would have been within the general level of skill in the art to make plural parts unitary as a matter of engineering choice (FR4). The examiner concludes that it would have been obvious to modify the receptacle of Mitchell by making a one piece top such that the top of the receptacle unit would be flush with the top surface of the article of furniture to provide an uninterrupted surface (FR4).

DISCUSSION

Grouping of claims

The claims are grouped to stand or fall together with the independent claims.

Byrne and Mitchell

We interpret the "means for selectively displacing said receptacle unit" to be the structure for allowing the receptacle unit to be displaced, as opposed to the structure for actually

causing the movement, such as a spring. Appellant does not contest that Byrne has means for selectively displacing the receptacle unit.

Claim 1 is taken as representative. Claim 16 differs from claim 1 in reciting a "plurality of sidewalls ... each of said sidewalls being recessed inwardly relative to the top of said receptacle unit" instead of "at least one sidewall" in claim 1, and claim 16 does not require any receptacle, whereas claim 1 requires "at least one receptacle."

Appellant argues that independent claims 1, 16, and 19 each define a device in which a top surface of a receptacle is planar with the top surface of an article of furniture in which the receptacle is mounted when the receptacle is in its retracted position and that this is not taught or suggested by the prior art, alone or in combination (Br8). It is argued that the top of the Byrne housing is above the top surface of a work surface in which the housing is mounted when the housing is in a retracted position. It is argued (Br9):

Modification of the Byrne patent, such that the top surface of the collar 116 is flush with the working surface 104 so that the top surface of the collar 116 is planar with the top of the working surface, would defeat the intended purpose and express objective of the arrangement of structure disclosed by Byrne, namely to enable the bottom surface of the collar 116 to provide a supporting surface for the housing 108 by permitting the outer perimeter of the collar 116 to overhang the slot 102.

It is argued that Mitchell does not teach or suggest an arrangement by which the top of a housing is planar with the top surface of a working surface when the housing is in a retracted position because Mitchell discloses that the top surface of the housing 50 is recessed below the top of a working surface 12 when the housing is in its retracted position and it is necessary to provide a removable closure element (a disk) over the opening to provide an uninterrupted work surface, which is distinctly different from the structural arrangement in claim 1 (Br10). It is argued that the only suggestion for the proposed modification is in appellant's own disclosure, which is improper (Br10-11).

The examiner responds (EA6): "Byrne discloses the invention substantially as claimed except for the surfaces being uninterrupted. The top of Byrne could/would fit in the recess 16 taught by Mitchell to provide an uninterrupted surface." The examiner states that as long as hindsight does not include any knowledge from applicant's disclosure, it is proper, citing In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971) (EA6).

Appellant replies (RBr2): "[T]he structure disclosed by the Byrne patent is arranged to enable the bottom surface of a collar 116 to provide a supporting surface for the housing 108 by permitting the outer perimeter of the collar 116 to overhang the slot 102. Therefore, providing Byrne with a top surface of the collar which is flush with the working surface would defeat the

intended purpose and express objective of the arrangement of structure disclosed by Byrne." It is also argued (RBr2): "Even if the Examiner's conclusion that the top of Byrne could/would fit in the recess taught by Mitchell to provide an uninterrupted surface, this is not the standard by which patentability is determined.... The only issue to be determined is if there is a suggestion or motivation in the prior art to combine the references as proposed by the Examiner in the final action." It is argued that there is no motivation in the prior art itself and the only basis for the combination must come from the improper use of appellant's own disclosure (RBr4).

The rejection could have been better stated. The statement that "[t]he top of Byrne could/would fit in the recess 16 taught by Mitchell to provide an uninterrupted surface" (EA6) does not clearly state the modification and improperly words the motivation. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992) (citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). The examiner's rote citation of McLaughlin does not answer the motivation issue. Nevertheless, we think it is apparent that what the examiner was trying to get at was that it

would have been obvious to one of ordinary skill in the art to recess the collar 116 of Byrne in the working surface so that the top of the collar 116 and cover plates 162 and 164 are level with the working surface given the teachings in Mitchell of a disk in a recess to provide an uninterrupted working surface when the receptacle is retracted. Thus, the motivation for the modification is found in Mitchell's teaching of providing a planar working surface when the receptacle is retracted and its solution of mounting the cover for the hole in a recess. This is similar to the well known technique of countersinking so that a flat-head screw is flush with the surface. We do not agree with appellant's argument that there is no motivation in the references because Mitchell expressly teaches that there should be an uninterrupted surface when the receptacle is retracted. We also do not agree with appellant's argument that providing a collar top surface flush with the working surface would defeat the intended purpose and objective of Byrne since the bottom of the collar would still support the housing 108. For these reasons, we affirm the rejection of claims 1-5 and 7-18.

Mitchell

In regard to the rejection of claim 1 over Mitchell alone, appellant argues that in Mitchell it is necessary to put a removable cover element (a disk) over the opening to provide an uninterrupted work surface, whereas claim 1 recites that the top

surface of the housing itself, when in its retracted position, is planar with the top surface of an article of furniture to provide an uninterrupted top working surface (Br11). Thus, it is argued, that "[a]pplicant's claimed article of furniture eliminates the need to provide a [sic] separate structural elements (a removable cover, an annular shoulder to support the removable cover), for providing an uninterrupted top working surface when the housing is in its retracted position" (Br11). It is argued that there is no motivation to modify Mitchell to render claim 1 obvious. It is argued that modification of Mitchell is not simply making plural parts unitary, since the housing 50 and the removable cover serve different functions and Mitchell provides a recessed annular shoulder 16 around the opening 14 solely to support the removable cover, but would require (1) providing a housing arranged so that the top surface is planar with a working surface when the housing is in its retracted position, (2) elimination of the removable closure element, and (3) eliminating the annular shoulder 16 (Br12). Appellant concludes that the structure in Mitchell is distinctly different from the structure of claim 1 (Br13) and the same arguments apply to claim 19 (Br13-14).

The examiner responds to the statement at Br13 by stating that (EA7): "Applicant's arguments do not clearly point out the patentable novelty which he thinks the claims present in view of the state of the art disclosed by the references cited or the

objections made. Further, they do not show how the claims avoid such references or objections."

Appellant replies that the structural differences are discussed at page 11 of the appeal brief and the examiner fails to respond to these specific arguments (RBr5).

We agree with appellant that the rejection does not account for the structural differences between claims 1 and 19 and Mitchell, which appellant has expressly pointed out. As noted by appellant, simply making the disk and the housing unitary will not produce the claimed invention. The user has to be able to depress the housing 50 to allow the spring and ratchet mechanism to work (Fig. 7), somewhat like the operating mechanism for a retractable ball point pen. If the disk were fixed to the top of the housing, the disk would need to be made correspondingly smaller and the annular shoulder 16 would be unnecessary, which modifications have not been addressed by the examiner's statement of the rejection. Mitchell is a good reference because it shows a housing mounted to the underside of a top surface of a piece of furniture, as recited in claim 16, and the housing receives a receptacle unit which has mechanical means (a spring) to selectively displace the receptacle unit. What is missing is the top of the receptacle unit being planar with the top surface of the article of furniture and we do not find this teaching or suggestion in Mitchell alone. Accordingly, the examiner has

failed to establish a prima facie case of obviousness. The rejection of claims 1, 2, 4-7, 10, 12-15, 19, and 20 is reversed.

Citation of other prior art

This panel cites the following additional prior art as relevant to the claimed subject matter, especially to the limitation of the top of the receptacle being planar with the top surface of the article of furniture:

Cole	3,646,244	February 29, 1972
Propst et al. (Propst)	4,372,629	February 8, 1983
Lecreux et al. (Lecreux)	5,888,078	March 30, 1999
	(§ 102(e) date	December 9, 1996)

Cole, Propst, and Lecreux all deal with retractable receptacles and, therefore, are analogous prior art.

Cole and Propst are mentioned in Byrne, which provides motivation for a combination. Cole discloses a retractable floor receptacle. "[T]he movable housing 10 with the cover plate 22 attached on the upper end thereof can slide vertically within the stationary casing 16 to either its hidden position flush with the level of the floor as illustrated by FIGS. 1 and 2 or to its withdrawn position above the level of the floor as illustrated by FIGS. 3 and 4" (col. 4, lines 7-12). Thus, Cole discloses a receptacle unit where the top of the receptacle unit is planar with the top surface when in the retracted position.

Propst discloses a cover 22 hinged to a vertical back panel of a piece of furniture with receptacles mounted to the lower

portion of the cover. Propst discloses that "[d]esk top 13 and cover 22 comprise a uniform planar surface interrupted only by brush 40" (col. 4, lines 53-55). Thus, Propst discloses a receptacle unit where the top of the receptacle unit is planar with the top surface when in the retracted position.

Lecreux describes a retractable service unit for the supply of energy or fluids. The unit includes a protective box preferably adapted to be sunk in the ground and a casing 14, having current outlets 16, which is raised by lifting means 30 (col. 3, first paragraph). The external surface of the cover 26 contains material suitable to the surroundings of the box and is planar with the surface (Fig. 1).

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CONCLUSION

The rejection of claims 1-5 and 7-18 is affirmed.

The rejection of claims 1, 2, 4-7, 10, 12-15, 19, and 20 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED- IN- PART

Lee E. Barrett

LEE E. BARRETT
Administrative Patent Judge

Anita Pollman Gross

ANITA PELLMAN GROSS
Administrative Patent Judge

Stuart S. Levy
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Appeal No. 2006-0159
Application 08/951,276

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Notice of References Cited	Application/Control No. 08/951,276	Applicant(s)/Patent Under Reexamination MCCARTHY, DAVID G.	
	Examiner	Art Unit BPAI	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-3,646,244	02-1972	COLE	174/57
	B	US-4,372,629	02-1983	PROPST ET AL.	312/223
	C	US-5,888,078	03-1999	LECREAUX ET AL.	439/131
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
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NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
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